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EXAMINER	
CERMAK, A	
ART UNIT	PAPER NUMBER
4	
DATE MAILED: 3/30/95	

12/28/95

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

<b>Office Action Summary</b>	Application No. <b>08/412,114</b>	Applicant(s) <b>Twardowski et al.</b>
	Examiner <b>Adam J. Cermak</b>	Group Art Unit <b>3306</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1 and 19-38 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1 and 19-38 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1      **Part III DETAILED ACTION**

2

3

*Specification*

4      The following is a quotation of the first paragraph of 35 U.S.C. § 112:

5            The specification shall contain a written description of the invention, and of the manner and process of  
6            making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art  
7            to which it pertains, or with which it is most nearly connected, to make and use the same and shall set  
8            forth the best mode contemplated by the inventor of carrying out his invention.

9            The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to  
10          adequately teach how to make and/or use the invention, i.e. failing to provide an enabling  
11          disclosure.

12          The specification is silent about the following:

13            (1)        The septum lying substantially at right angles to a plane essentially defined by the  
14            proximal and distal portions.

15            (2)        The angle contained between the proximal and distal portions specifically being  
16            on 0-20 degrees.

17            (3)        The proximal portion (of the body) being more rigid than the distal portion.

18

19          *Claim Rejections - 35 USC § 112*

20          Claims 19 - 37 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set  
21          forth in the objection to the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

\* \* \*

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4405313 issued to Sisley et al ("Sisley").

Claim 1 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by both of U.S. Patent No. 4981477 issued to Schon et al ("Schon") and U.S. Patent No. 5171216 issued to Dasse et al ("Dasse").

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various

1 claims was commonly owned at the time any inventions covered therein were made absent any  
2 evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point  
3 out the inventor and invention dates of each claim that was not commonly owned at the time a  
4 later invention was made in order for the examiner to consider the applicability of potential 35  
5 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

6 Claims 19 - 38 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the  
7 alternative, under 35 U.S.C. § 103 as obvious over Sisley.

8 Claims 19 - 38 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the  
9 alternative, under 35 U.S.C. § 103 as obvious over both of Schon and Dasse.

10  
11 In Paper No. 3 ["PRELIMINARY AMENDMENT AND REQUEST THAT AN  
12 INTERFERENCE BE DECLARED UNDER 37 C.F.R. § 1.607"], at page 11, Applicants  
13 state, ". . . all claims in the involved cases which are directed to patentably indistinct subject  
14 matter should be designated as corresponding to the count. Thus, Martin claims 1-19 and  
15 applicants' claims 1 and 19-38 should all be designated as corresponding to the count." Thus,  
16 it is Applicants' belief that claims 1 and 19-38 are all directed to the same patentable invention,  
17 and are patentably indistinct. Note should be taken that Applicants go to great pains, see Paper  
18 No. 3, at pages 8 and 9, to explain that 'patentably indistinct' involves the familiar standards  
19 under 35 U.S.C. §§ 102 and 103. See also 37 C.F.R. § 1.601(n).

20 Therefore, Applicants acknowledge and admit that claims 1 and 19-38 are not patentably  
21 distinct. As claim 1 is not patentable to Applicant over the patents issued to Sisley, Schon, and  
22 Dasse, Applicants therefore admit that claims 19-38 are unpatentable over these references'  
23 teachings.

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***Response to Amendment***

2       (1)     The amendment filed March 28, 1995 is objected to under 35 U.S.C. § 132 because it  
3 introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall  
4 introduce new matter into the disclosure of the invention. The added material which is not  
5 supported by the original disclosure is as follows: the deletion, at page 29, lines 6 and 7, of "on  
6 the order of approximately 50 - 90 [degrees]".

7              Applicant is **required** to cancel the new matter in the response to this Office action.

8       (2)     The threshold issue in interference practice is the patentability of claims to the Applicant.  
9       37 C.F.R. § 1.606 (1995) ("Before an interference is declared between an application and an  
10 unexpired patent, an examiner must determine that there is interfering subject matter claimed  
11 in the application and the patent *which is patentable to the applicant* subject to a judgment in the  
12 interference.") (emphasis added). As detailed above, the subject matter claimed by the Applicant  
13 in the instant application, which is alleged to interfere with that claimed in the *Martin* patent,  
14 is not patentable to Applicant. Therefore, the REQUEST THAT AN INTERFERENCE BE  
15 DECLARED UNDER 37 C.F.R. § 1.607, Paper No. 3, is DENIED.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Adam J. Cermak who can be reached by any of the following means:

Direct telephone with voicemail . . . . . (703) 308-2110  
Telefacsimile . . . . . (703) 308-3139  
E-mail . . . . . acermak@pioneer.uspto.gov

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist whose telephone number is (703) 308-0858.

Examiner Cermak is generally available Mondays through Fridays from 8 am to 4:30 pm (Eastern). If he is not available to take a call, a message may be left with the Group 3300 receptionist. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, C. Fred Rosenbaum, can be reached on (703) 308-2991.

Note that papers of record may be submitted to Group 3300 by telefacsimile at the number noted above; see 1096 OFF. GAZ. PAT. OFFICE 30 (October 19, 1988) and 1156 OFF. GAZ. PAT. OFFICE 61 (November 16, 1993). Submission of a confirmation copy through the mailroom is not required; duplicate submissions are discouraged since entry of two copies of the same paper tends to confuse the record. Applicant should, however, retain in their own file the original copy of any formal paper which is submitted by telefacsimile.

Messages transmitted by telefacsimile which are not formal papers should reach the Examiner promptly. To expedite their delivery, they should be clearly marked on the first page as INFORMAL COMMUNICATION, COURTESY COPY, or the like. It is also a good idea to call the Examiner when an informal communication is transmitted so that he knows to expect it.

The Examiner will check his E-mail messages at least every morning. There is at present no procedure which allows for the submission of formal communications to the P.T.O. via E-mail. See 37 C.F.R. § 1.2 (1995).

AJC:ajc  
20 December 1995



JOHN D. YASKO  
PRIMARY EXAMINER  
ART UNIT 336